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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,928	04/08/2004	Philip F. Williams III	OSTEONICS 3.0-477	8757
530 7590 12/11/2007 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER IZQUIERDO, DAVID A	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 12/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/820,928

**Applicant(s)**

WILLIAMS ET AL.

**Examiner**

David A. Izquierdo

**Art Unit**

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17, 18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14, 17, 18 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 10, 12, 13 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 8 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 September 2007 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 24 September 2007 have been fully considered but they are not persuasive. Applicant has amended the claims to further define the elongate slots as having a length and width wherein the length is greater than the width. However, Applicant have not defined which axis defines the length and which axis defines the width. As seen in Figure 3 of the prior art reference, Duvillier et al. (US 5,749,876), Duvillier et al. discloses a first body portion with an elongate slot wherein the longitudinal direction of the slot is less than the transverse direction. Examiner is considering the longitudinal direction the width and the transverse direction the length, thereby meeting the claimed limitations.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 9, 10, 12, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duvillier et al (U.S. Patent Number 5,749,876) in view of Lionberger et al. (U.S. Patent Application Publication Number 2004/0260301). Duvillier et al discloses a bone cutting apparatus comprising:

- A first body (302) portion having an aperture extending therethrough (Claim 1);
- A stainless steel second body portion (303) coupled to the first body portion wherein the second body portion comprises a cutting slot in communication with the aperture of the first body portion and further comprising a first surface and a second surface which face the bone and the first body portion respectively (Claims 1, 2, 6, 7, 9, 10);
- A stainless steel third body portion (301) coupled to the first body portion wherein the third body portion comprises a cutting surface in communication with the aperture of the first body portion and the cutting surface of the second body portion (Claim 3, 6, 7);
- Pins (313) which interact with all body portions and further secure the body portions to the bone surface (Claims 4, 5, 12, 13);

5. however Duvillier et al. fails to disclose a bone cutting apparatus comprising a polymeric material. Lionberger et al. teaches a guide made of a polymer (col. 28, line 2). It would have been obvious to one of ordinary skill in the art to combine the teaching of a polymeric guide, or body portion, as taught by Lionberger et al., to a bone cutting apparatus, as per Duvillier, the

motivation to combine being that a polymeric material allows for the guide to be manufactured of disposable material allowing for guide to be single use, eliminating error cause by wear on the guide, as found in Lionberger et al. (Col. 28, line 2).

*Allowable Subject Matter*

6. Claims 14, 17, 18 and 20 are allowable over the prior art of record.
7. Claims 8 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Izquierdo whose telephone number is 571-272-1943. The examiner can normally be reached on Monday through Friday from 8:00 am until 4:30 pm.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David A. Izquierdo



Patent Examiner



**CORRINE McDERMOTT**  
**SUPERVISORY PATENT EXAMINER**  
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